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Rai Abhyanker

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EXAMINER

GREENE, DANIEL LAWSON

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3
4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* RAI ABHYANKER,
9 ALEX PANELLI, and
10 KRISHNASWA SURESH
11

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13 Appeal 2009-000736
14 Application 09/774,449
15 Technology Center 3600
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18 Decided: December 23, 2009
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21 Before HUBERT C. LORIN, ANTON W. FETTING, and JOSEPH A.
22 FISCHETTI, *Administrative Patent Judges*.
23 FETTING, *Administrative Patent Judge*.

24 DECISION ON APPEAL
25

STATEMENT OF THE CASE

Rai Abhyanker, Alex Panelli, and Krishnaswa Suresh (Appellants) seek review under 35 U.S.C. § 134 (2002) of a final rejection of claims 1-6, 9-14, and 17-22, the only claims pending in the application on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION¹

We AFFIRM.

THE INVENTION

The Appellants invented a system and method for financing and for consolidating financing in an internet exchange portal (Specification 1:8-9).

An understanding of the invention can be derived from a reading of exemplary claims 1 and 2, which are reproduced below [bracketed matter and some paragraphing added].

1. A method for consolidating financing in an internet exchange portal, comprising the steps of:

[1] receiving at the internet exchange portal a set of financing applications at the internet exchange portal;

¹ Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed November 28, 2007) and Reply Brief ("Reply Br.," filed April 28, 2008), and the Examiner's Answer ("Ans.," mailed February 26, 2008), and Final Rejection ("Final Rej.," mailed March 1, 2007).

- 1 [2] generating at the internet exchange portal a generic
2 financing application from the set of applications;
3 [3] receiving data for the generic financing application; and
4 [4] populating the set of financing applications with the data.

5

6 2. The method of claim 1, where:

- 7 [1] the receiving step includes the step of receiving a set of
8 financing applications each including a set of data fields; and
9 [2] the generating step includes the step of consolidating
10 similar sets of data fields in each financing application into a
11 generic data field in the generic financing application.

12

13 THE REJECTIONS

14 The Examiner relies upon the following prior art²:

Sinclair	US 6,208,979 B1	Mar. 27, 2001
Maxwell et al.	US 6,589,290 B1	Jul. 8, 2003

15

16 Claims 1-2, 9-10, and 17-18 stand rejected under 35 U.S.C. § 103(a) as
17 unpatentable over Maxwell.

18 Claims 3-6, 11-14, and 19-22 stand rejected under 35 U.S.C. § 103(a) as
19 unpatentable over Maxwell and Sinclair.

20

² The Examiner has cited Abelow (US 5,787,415), Steele et al. (US 2002/0072975 A1), Schweitzer et al. (US 6,418,467 B1), Jacobsen et al. (US 5,787,415), and Thompson, III (US 2004/0167877 A1) in support of an asserted Official Notice (Final Rej. 6).

ISSUES

The issues pertinent to this appeal are:

- Whether the Appellants have sustained the burden of showing that the Examiner erred in rejecting claims 1-2, 9-10, and 17-18 under 35 U.S.C. § 103(a) as unpatentable over Maxwell.
 - This pertinent issue turns on whether Maxwell describes limitation [2] of claims 1 and 2.
- Whether the Appellants have sustained the burden of showing that the Examiner erred in rejecting claims 3-6, 11-14, and 19-22 under 35 U.S.C. § 103(a) as unpatentable over Maxwell and Sinclair.
 - This pertinent issue turns on whether the Appellants' arguments in support of claims 1-2, 9-10, and 17-18 are found to be persuasive.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to the Prior Art

Maxwell

01. Maxwell is directed to a method and apparatus for populating a form with data (Maxwell 1:7-9).
02. Maxwell describes a web client connected to a computer network such as the Internet (Maxwell 8:1-3). The web client

contains computer code, such as a form completion program (Maxwell 8:4-6). The system further contains forms and each form has one or more data receptacles (Maxwell 8:13-17). The data receptacles are filled with data when the user executes a data population command (Maxwell 8:13-17). The form completion program collects data from a user and a user enters information using a user interface where a user can enter data for specific fields (Maxwell 8:19-23). The form completion program searches for a template file, among a plurality of template files, that resembles the form image (Maxwell 8:27-32). When a match is determined the program utilizes the template file to identify what kind of data to insert into each of the form's data receptacles and inputs the appropriate kind of data into the appropriate data receptacle (Maxwell 8:45-55). A template file comprises a collection of form descriptions and each form description is associated with a form (Maxwell 12:55-58). A single form description may also represent multiple forms (Maxwell 12:58-60). A single template file may represent more than one form and the generic template may be created and later verified by an independent party (Maxwell 13:48-51).

03. The form completion program aids in the process of collecting data from the user by prompting the user for information likely to be required to complete a form (Maxwell 10:59-61). Once information is collected from a user, the form completion program creates a graphic that is representative of the type of information collected (Maxwell 10:65-67). For example, information such as

1 name and address information is stored under the graphic icon for
2 personal information (Maxwell 11:6-12). The user may customize
3 the data set associated with a graphic and the graphics associated
4 with the data set (Maxwell 11:12-15).

5 04. The form completion program interacts with a target application
6 (e.g. web browser) installed at the web client to provide the user
7 with a mechanism for filling out multiple forms (Maxwell 9:36-
8 39). These files can be used to construct forms (Maxwell 2:21-
9 24). After a file has been requested it is sent from the web server
10 to the web client and is ready for display by embedding the file
11 into a web page (Maxwell 2:53-54 and 3:1-3). The web client
12 accesses the web server via a network, such as the Internet
13 (Maxwell 2:3-6 and 2:17-21).

14 *Sinclair*

15 05. Sinclair is directed to a computer-drive information
16 management system for selectively matching credit applications
17 with money lenders through a global communications network
18 (Sinclair 1:15-19).

19 *Facts Related To The Level Of Skill In The Art*

20 06. Neither the Examiner nor the Appellants has addressed the level
21 of ordinary skill in the pertinent art of financial systems. We will
22 therefore consider the cited prior art as representative of the level
23 of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d
24 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings
25 on the level of skill in the art does not give rise to reversible error

“where the prior art itself reflects an appropriate level and a need for testimony is not shown”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

Facts Related To Secondary Considerations

07. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Obviousness

A claimed invention is unpatentable if the differences between it and the prior art are “such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that the obviousness analysis is bottomed on several basic factual inquiries: “[(1)] the scope and content of the prior art are to be determined; [(2)] differences between the prior art and the claims at issue are to be ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved.” *Graham*, 383 U.S. at 17. *See also KSR*, 550 U.S. at 406. “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, 550 U.S. at 416.

ANALYSIS

*Claims 1-2, 9-10, and 17-18 rejected under 35 U.S.C. § 103(a) as
unpatentable over Maxwell*

The Appellants first contend that (1) Maxwell fails to describe “generating a generic financing application from the set of applications”, as required by claims 1, 9, and 17. App. Br. 11-12. The Appellants specifically argue that Maxwell fails to describe a *generic application* and further fails to describe that such a generic application is generated *from a set of applications*. App. Br. 11.

We disagree with the Appellants. Maxwell describes a web-based system that uses a form completion program to provide a user with a method of filling out multiple forms using a data population technique. FF 02 and FF 04. Maxwell further describes that a single generic template file may represent multiple forms and a user can use this generic template file to populate multiple forms. FF 02. That is, a single generic template file can be created such that it includes data fields that are required for a set of forms or applications.

The Appellants further contend that this description from Maxwell only describes creating and using a template to complete forms and is not the same as generating a generic application from a set of applications. Reply Br. 3. However, the generic template contains information required by multiple forms and as such must have been generated in response to a finding that the same data fields are required by multiple forms. That is, the generic template is generated to collect information based on the information needed for, and therefore predictably coming from, multiple forms. As such,

1 Maxwell describes the generation of a generic template or application based
2 on a set of forms or applications. The claim does not further narrow the
3 manner in which such generation or such basis occurs, so generation from a
4 database that is populated from multiple forms would fall within the scope
5 of the claim as drafted.

6 The Appellants also contend that (2) Maxwell fails to describe an
7 internet exchange portal generates a generic financing application, as
8 required by claims 1, 9, and 17. App. Br. 12. We disagree with the
9 Appellants. Maxwell describes technical architecture that includes a web
10 server that stores the forms and templates and a web client accesses the web
11 server through a network such as the Internet. FF 04. As such, an internet
12 portal is used to fill out templates and forms and Maxwell describes this
13 limitation of claims 1, 9, and 17.

14 The Appellants further contend that (3) Maxwell fails to describe
15 receiving financial applications and then consolidating similar fields of these
16 financial applications into a generic data field in the financial application, as
17 required by claims 2, 10, and 18. App. Br. 12. We disagree with the
18 Appellants. Maxwell describes that the form completion program collects
19 data for specific fields from the user. FF 03. The data fields collected from
20 a user are further consolidated into a single graphical representation of the
21 data set. FF 03. For example, information such as name and address data is
22 consolidated under a single graphical icon representing personal
23 information. FF 03. That is, a user need only select the data set of personal
24 information when entering information since that data set has consolidated
25 the personal information data fields. As such, Maxwell describes this
26 feature of claims 2, 10, and 18.

1 The Appellants additionally contend that (4) the recited term “financial”
2 is not a non-functional descriptive matter and therefore should be given
3 patentable weight. App. Br. 13. We disagree with the Appellants. The term
4 “financial” is being used in the claims to describe the term “applications.”
5 The term “financial” is merely describing the type of applications and field
6 of use of the applications and does not impart any functionality to the
7 claimed structure or alter the process steps of the claimed invention. In
8 other words, the claims do not further recite any limitations that impose any
9 “financial” specific functionality. As such, the term “financial” is merely
10 non-functional descriptive matter and should not be given patentable weight.
11 Nonfunctional descriptive material cannot render nonobvious an invention
12 that would have otherwise been obvious. *In re Ngai*, 367 F.3d 1336, 1339
13 (Fed. Cir. 2004). *Cf. In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983)
14 (when descriptive material is not functionally related to the substrate, the
15 descriptive material will not distinguish the invention from the prior art in
16 terms of patentability).

17 The Appellants have not sustained the burden of showing that the
18 Examiner erred in rejecting claims 1-2, 9-10, and 17-18 under 35 U.S.C.
19 § 103(a) as unpatentable over Maxwell.

20
21 *Claims 3-6, 11-14, and 19-22 rejected under 35 U.S.C. § 103(a) as*
22 *unpatentable over Maxwell and Sinclair*

23 The Appellants contend that Sinclair fails to cure the deficiencies of
24 Maxwell with respect to the independent claims and claims 3-6, 11-14, and
25 19-22 are allowable for the same reasons. App. Br. 13. We disagree with

1 the Appellants. The Appellants' contention that Sinclair fails to cure
2 Maxwell's deficiencies does not persuade us of error on the part of the
3 Examiner because the Appellants are responding to the rejection by
4 attacking the references separately, even though the rejection is based on the
5 combined teachings of the references. Nonobviousness cannot be
6 established by attacking the references individually when the rejection is
7 predicated upon a combination of prior art disclosures. *See In re Merck &*
8 *Co. Inc.*, 800 F.2d 1091, 1097(Fed. Cir. 1986).

9 The Appellants have not sustained the burden of showing that the
10 Examiner erred in rejecting claims 3-6, 11-14, and 19-22 under 35 U.S.C.
11 § 103(a) as unpatentable over Maxwell and Sinclair.

12 13 CONCLUSIONS OF LAW

14 The Appellants have not sustained the burden of showing that the
15 Examiner erred in rejecting claims 1-2, 9-10, and 17-18 under 35 U.S.C.
16 § 103(a) as unpatentable over Maxwell.

17 The Appellants have not sustained the burden of showing that the
18 Examiner erred in rejecting claims 3-6, 11-14, and 19-22 under 35 U.S.C.
19 § 103(a) as unpatentable over Maxwell and Sinclair.

20 21 DECISION

22 To summarize, our decision is as follows.

- The rejection of claims 1-2, 9-10, and 17-18 under 35 U.S.C. § 103(a) as unpatentable over Maxwell is sustained.
- The rejection of claims 3-6, 11-14, and 19-22 under 35 U.S.C. § 103(a) as unpatentable over Maxwell and Sinclair is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2008).

AFFIRMED

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